

REMARKS

The Applicants have carefully reviewed the Final Office Action mailed November 30, 2006 and offer the following remarks.

Claims 1, 7, 8, 13, 19, 20, 25, 31, 32, and 44-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0062336 A1 to *Teodosiu et al.* (hereinafter "*Teodosiu '336*"). The Applicants respectfully traverse the rejection.

According to 35 U.S.C. § 102(e), a person shall be entitled to a patent unless "the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent." The Applicants submit that *Teodosiu '336* is not a proper reference under 35 U.S.C. § 102(e). In particular, the present application has a filing date of March 21, 2001. *Teodosiu '336* has a filing date of September 13, 2001, after the filing date of the present application. Nevertheless, *Teodosiu '336* claims priority to Provisional Application No. 60/252,658 hereinafter "*Teodosiu '658*") and 60/252,659 (hereinafter "*Teodosiu '659*"), which were filed on November 22, 2000. According to Chapter 201.11 of the M.P.E.P., the "later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112." The disclosure of *Teodosiu '336* is different from the disclosures of both *Teodosiu '658* and *Teodosiu '659*. Moreover, all the subject matter disclosed in *Teodosiu '336* is not disclosed in *Teodosiu '658* and *Teodosiu '659* in accordance with the first paragraph of 35 U.S.C. § 112. Therefore, all the subject matter disclosed in *Teodosiu '336* is not entitled to the filing date of *Teodosiu '658* and *Teodosiu '659* such that *Teodosiu '336* is not a proper reference under 35 U.S.C. § 102(e). As such, the Applicants will address *Teodosiu '658* and *Teodosiu '659* in responding to the Final Office Action.

According to Chapter 2131 of the M.P.E.P., in order to anticipate a claim under 35 U.S.C. § 102, "the reference must teach every element of the claim." The Applicants respectfully submit that neither *Teodosiu '658* nor *Teodosiu '659* disclose each and every element recited in claims 1, 7, 8, 13, 19, 20, 25, 31, 32, and 44-46. Accordingly, these references cannot anticipate these claims. More specifically, claim 1 recites a method for optimizing

private network file transfers comprising, among other features, “determining by the server that the first and second nodes are part of the same private network.” Claims 13 and 25 include similar features. The Applicants submit that neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose or even suggest that a server determines that first and second nodes are part of the same private network. While these references do disclose a server which interacts with nodes, neither reference discloses or even suggests that the server determines that first and second nodes are part of the same private network. As such, claims 1, 13, and 25 are patentable over both *Teodosiu* ‘658 and *Teodosiu* ‘659.

Claim 7 recites allowing a user of the first node to “enter search terms for finding a particular file.” Claims 19 and 31 include similar features. The Applicants submit that neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose or suggest that a user at a first node enters a search term for finding a particular file. In fact, neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose entering a search term to find anything, much less a particular file. As such, in addition to the reasons listed above, claims 7, 19, and 31 are patentable over *Teodosiu* ‘658 and *Teodosiu* ‘659.

Claim 8 recites “querying a database containing file names with the search terms to find file names matching the search terms.” Claims 20 and 32 include similar features. The Applicants submit that neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose or suggest querying a database with search terms to find file names that match the search terms. As mentioned above, neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose anything relating to search terms. Thus, neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 can disclose querying a database with search terms to find file names which match search terms. Accordingly, in addition to the reasons noted above, claims 8, 20, and 32 are patentable over *Teodosiu* ‘658 and *Teodosiu* ‘659.

Claim 44 recites “receiving by the server the search request from the first node including at least one search term identifying the file.” Claim 44 also recites “querying a database relating each one of a number of files including the file and at least one of the plurality of nodes in the peer-to-peer public network storing the one of the number of files using the at least one search term to identify at least one of the plurality of nodes including the second node storing the file.” Claims 45 and 46 include similar features. As detailed above, neither *Teodosiu* ‘658 nor *Teodosiu* ‘659 disclose or suggest receiving a search term or querying a database using a search term, as recited in claims 44-46. Thus, in addition to the reasons noted above, claims 44-46 are patentable over *Teodosiu* ‘658 and *Teodosiu* ‘659.

Claims 2-6, 9-12, 14-18, 21-24, 26-30, 33-43, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Teodosiu* '336 in view of U.S. Patent No. 6,510,154 B1 to *Mayes et al.* (hereinafter "*Mayes*"). The Applicants respectfully traverse the rejection. As indicated above, *Teodosiu* '336 is not a valid reference under 35 U.S.C. § 102(e). However, for purposes of addressing the rejection, the Applicants will address *Teodosiu* '658 and *Teodosiu* '659 in view of *Mayes*.

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Applicants respectfully submit that neither *Teodosiu* '658, *Teodosiu* '659, nor *Mayes*, either singularly or in combination, disclose or suggest all the features recited in claims 2-6, 9-12, 14-18, 21-24, 26-30, 33-43, and 47.

Claim 37 recites a method for optimizing private network file transfers comprising, among other features, "determining that the second node is part of the same private network as the first node." As detailed above, neither *Teodosiu* '658, *Teodosiu* '659, nor *Mayes*, either singularly or in combination, disclose or suggest determining that a second node is part of the same private network as a first node. Thus, claim 37 is patentable over *Teodosiu* '658, *Teodosiu* '659, and *Mayes*.

Regarding claims 2-5, 12, 14-17, 24, 26-29, 36, 38-41, and 43, as mentioned above, neither *Teodosiu* '658 nor *Teodosiu* '659, either singularly or in combination, disclose or suggest all the features recited in claims 1, 13, 25, and 37, the base claims from which claims 2-5, 12, 14-17, 24, 26-29, 36, 38-41, and 43 variously depend. Similarly, *Mayes* does not address the previously noted shortcomings of *Teodosiu* '658 and *Teodosiu* '659, namely, determining that a first node and a second node are part of the same private network. As such, these claims are patentable over *Teodosiu* '658 and *Teodosiu* '659 in view of *Mayes*.

Claim 6 recites storing "the client IP address, a subnet mask, and a peer IP address of both the first and second nodes in a node registry." Claims 18 and 30 include similar features. The Applicants submit that none of the references, either singularly or in combination, disclose or suggest the feature of storing a client IP address, a subnet mask, and a peer IP address of a first node and a second node in a node registry. In particular, none of the cited references disclose a node registry. Since none of the references disclose a node registry, it follows that none of the references can disclose storing a client IP address, a subnet mask, and a peer IP

address of a first node and a second node in a node registry. Therefore, in addition to the reasons noted above, claims 6, 18, and 30 are patentable over *Teodosiu* '658, *Teodosiu* '659, and *Mayes*.

Claim 9 recites “determining that the second node is part of the same private network as the first node, and therefore locally reachable by the first node.” Claims 21 and 33 include similar features. As discussed above, neither *Teodosiu* '658, *Teodosiu* '659, nor *Mayes* disclose or suggest determining that a second node is part of the same private node as the first node. In addition, none of the references, either singularly or in combination, disclose or suggest that by virtue of a first node and a second node being part of the same private network, the second node is locally reachable by the first node. As such, claims 9, 21, and 33 are patentable over *Teodosiu* '658, *Teodosiu* '659, and *Mayes* for these additional reasons. Similarly, claims 10, 22, and 34, which variously depend from claims 9, 21, and 33, are patentable for at least the same reasons and the novel features recited therein.

Claim 11 recites “sorting the search results first by locally reachable nodes followed by the directly reachable nodes.” Claims 23, 35, and 42 include similar features. The Applicants submit that neither *Teodosiu* '658, *Teodosiu* '659, nor *Mayes* disclose or suggest sorting search results first by “locally” reachable nodes followed by “directly” reachable nodes. Accordingly, in addition to the reasons noted above, claims 11, 23, 35, and 42 are patentable over *Teodosiu* '658, *Teodosiu* '659, and *Mayes*.

Claim 47 recites “receiving by the server the search request from the first node including at least one search term identifying the file, and step (c) comprises querying a database relating each one of a number of files including the file and at least one of the plurality of nodes in the peer-to-peer public network storing the one of the number of files using the at least one search term to identify at least one of the plurality of nodes including the second node storing the file.” The Applicants submit that neither *Teodosiu* '658, *Teodosiu* '659, nor *Mayes*, either singularly or in combination, disclose or suggest these features. As mentioned above, neither *Teodosiu* '658 nor *Teodosiu* '659 disclose entering a search term. Likewise, *Mayes* does not disclose anything about searching. As such, none of the references can disclose receiving a search request and querying a database using a search term. Therefore, in addition to the reasons noted above, claim 47 is patentable over *Teodosiu* '658, *Teodosiu* '659, and *Mayes*.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: January 23, 2007
Attorney Docket: 1104-041